

c.) Remarks

Initially, Applicants wish to acknowledge the courtesies and assistance extended by Examiner Solola during the Personal Examiner Interview of October 22, 2008. The Examiner's efforts in expediting the prosecution of this application are gratefully appreciated.

Claims 1, 3, 15, 16, 21 and 23-27 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the claims contain subject matter that was not adequately described in the specification as to reasonably convey the inventors had possession of the claimed invention at the time the application was filed. The basis for this rejection is the amendment to "the specification filed 10/30/07". (Office Action at page 2 lines 14-16.)

Although this rejection is respectfully traversed, that amendment has above been deleted. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 3, 15, 16, 21 and 23-27 stand rejected under 35 USC §112, first paragraph, as failing to reasonably provide enablement for the compounds. According to the Examiner,

"[t]he original specification and claims (5/17/99) fail to disclose how the derivatives are made. There is a disclosure of obtaining epothilones C-D from a microorganism but no disclosure how the derivatives are obtained from the isolated compounds or how epothilones A and B are de-epoxidized to C and D respectively."  
(Office Action at page 4, lines 1-4.)

As to claims 21 and 23-27, this rejection is mooted by the forgoing amendment. As to claims 1, 3, 15 and 16, the Examiner agreed during the October 22 Interview that such claims were enabled by the specification as filed.

Lastly, claims 1, 3, 15, 16, 21 and 23-27 stand rejected under 35 USC 102(b) as anticipated by DE 195 42 986.9. However, as explained during the October 22 Interview, this reference is not prior art under 35 USC §102(b) and is not a statutory bar. That is, DE 195 42 986.9 was published May 29, 1997 while the present application is a 35 USC §111 Continuation of PCT/EP97/06442 (filed November 18, 1997), that claims benefit of DE 197 07 506.1 (filed February 25, 1997) and DE 196 97 580.5 (filed November 18, 1996).

As also discussed during the October 22 Interview, the filing dates of both DE 197 07 506.1 and DE 196 97 580.5 are prior to the publication date of DE 195 42 986.9. In this regard, certified copies and verified English-language translations of DE 197 07 506.1 and DE 196 97 580.5 are of record in Interference No. 105,298. (In any event, Applicants established in Gerhard Hoefle's Declaration under Rule 131 filed June 11, 2008 that the present invention was actually reduced to practice on June 13, 1996 and June 20, 1996. Both of these dates, too, are prior to the publication of DE 195 42 986.9.) Accordingly, this rejection too is overcome and should be withdrawn.

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 1, 3, 15 and 16 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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